

## **Remarks**

### **35 U.S.C. §101 rejections**

In the papers mailed September 26, 2011 claim 36, claim 37, claim 39, claim 40, claim 41, claim 42, claim 55, claim 56, claim 57, claim 58, claim 59 and claim 60 are rejected under 35 U.S.C. §101. The Assignee notes that all these claim rejections are moot as claim amendments have obviated these rejections by highlighting the transformation of data to a different state or thing, changing claim 55, claim 56, claim 57, claim 58, claim 59 and claim 60 to apparatus claims and by highlighting the technical nature of the claimed invention by including the algorithms used in the innovative method, system and program storage device described in the instant application.

### **35 U.S.C. § 103 rejections**

In the papers mailed September 26, 2011 claim 36, claim 37, claim 39, claim 41, claim 42, claim 46, claim 47, claim 48, claim 55, claim 58, claim 59, claim 60, claim 76, claim 77, claim 78, claim 79, claim 80, claim 82, claim 83, claim 84, claim 85, claim 86, claim 88, claim 90, claim 91, claim 92, and claim 93 are rejected under 35 USC §103(a) as being unpatentable over Bielinski alone or in view of Baur. Claim 57 and 81 are rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Baur and Davis. Claim 40 is rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Baur and Bigus (6,192,354). Claim 50 is rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Baur and Stork (5,245,696). Claim 38, claim 49, claim 50, claim 51, claim 52, claim 56, claim 78, claim 87 and claim 89 is rejected under 35 USC §103(a) as being unpatentable over Bielinski in view of Mauoboussin. The Assignee notes that all these claim rejections are moot as claim amendments have obviated these rejections by highlighting the transformation of data to a different state or thing, changing claim 55, claim 56, claim 57, claim 58, claim 59 and claim 60 to apparatus claims and by highlighting the technical nature of the claimed invention by including the algorithms used in the innovative method, system and program storage device described in the instant application.

### **35 U.S.C. §112 first and second paragraph rejections**

In the papers mailed September 26, 2011 claim 36, claim 37, claim 38, claim 39, claim 41 and claim 42 are rejected under 35 USC §112 first paragraph as the author of the papers claims that the specification does not describe an enterprise or elements of value that physically exist. In the papers mailed September 26, 2011 claim 36, claim 37, claim 38, claim 39, claim 41, claim

42, claim 46, claim 55 and claim 72 are rejected under 35 U.S.C. §112 second paragraph as the author of the papers claims that the specification does not describe an enterprise or elements of value that physically exist. The Assignee traverses all §112 first paragraph and second paragraph rejections related to the physical existence limitations in a number of ways, including noting that the claim rejections have been provided in spite of the fact that the MPEP specifically teaches that there is no basis for these rejections. In particular, MPEP 2173.05 (e) states in part: *There is no requirement that the words in the claim must match those used in the specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.* Furthermore, the specification of a U.S. patent application is not required to provide "antecedent basis" for the claim language. U.S. law (specifically 35 U.S.C. 112, first paragraph) requires the specification of an application to describe the claimed invention in writing in such a way as to enable one of ordinary skill to make and use the invention without undue experimentation. Put another way, there is no statutory basis for characterizing the alleged failure of a specification to provide "antecedent basis" for the elements of a claim as a violation of 35 U.S.C. 112, first paragraph. Kindly note that the papers mailed September 26, 2011 do not identify any need for experimentation. Since no confusion has been alleged regarding the metes and bounds of the term "physically exists" there is also no statutory basis for a 35 U.S.C. 112, second paragraph rejection of these claims. The Assignee also notes that all these claim rejections are moot as claim amendments have obviated these rejections by highlighting the transformation of data to a different state or thing, changing claim 55, claim 56, claim 57, claim 58, claim 59 and claim 60 to apparatus claims and by highlighting the technical nature of the claimed invention by including the algorithms used in the innovative method, system and program storage device described in the instant application.:.

#### **Material from co-pending applications**

Under the provisions of MPEP § 2001.06(b), the author of the set of papers recently mailed with respect to the instant application is hereby advised of information obtained from co-pending U.S. Patent Application(s) which may be "material to patentability" of the instant application (see *Armour & Co. v. Swift & Co.*, 466 F.2d 767, 779, 175 USPQ 70, 79 7th Cir. 1972).

The subject matter contained in the patent applications listed below may be deemed to relate to the present application, and thus may be felt (with or without reasonable justification) to be material to the prosecution of the instant application.

- Copies of cited U.S. patent application(s) (office actions, specification, claims, and the drawings) or copies of the portion(s) of the application(s) which caused it(them) to be cited, including any claims directed to such portion(s) are attached hereto.
- Copies of the cited U.S. Patent Application(s) (office actions, specification, claims, and the drawings) and U.S. Patents are available on the U.S.P.T.O.'s Image File Wrapper. Therefore copies thereof need not be attached.
- The materials in the envelope are considered trade secrets and are being submitted for consideration under MPEP § 724.

On May 5, 2007 the Assignee provided a list of co-pending applications. The table below lists the co-pending applications that have been filed since May 5, 2007.

<u>Application No.</u>	<u>Title</u>	<u>Filing Date</u>
1. 12/114,784	Complete Context™ Query System	5/4/2008
2. 12/185,093*	Risk management system	8/3/2008
3. 12/271,846	An organization activity management system	11/15/2008
4. 12/356,505	A segmented predictive model system	1/20/2009
5. 12/370,574	A contextual management system	2/12/2009
6. 12/497,656	A personalized medicine system	7/4/2009
7. 12/545,851	A personalized modeling system	8/23/2009
8. 12/684,954	An extended management system	1/10/2010
9. 12/910,829	Personalized commerce system	1/17/2011
10. 13/239,241	Personalized medicine system	9/21/2011
11. 13/300,605	Complete Context™ Search System	11/20/2011

Any and all of the listed co-pending applications are not to be construed as prior art. By bringing the above-listed information to the attention of the author, the Assignee does NOT waive any confidentiality concerning the above-listed co-pending application(s) or this application. See

MPEP §101. Furthermore, if said application(s) should not mature into patents, such application(s) should be preserved in secrecy under the provisions of 35 U.S.C. § 122 and 37 C.F.R. § 1.14.

**Statement under 37 CFR 1.111**

37 CFR 1.111 requires that the basis for amendments to the claims be pointed out after consideration of the references cited or the objections made. The Assignee notes that this requirement is not relevant to the instant application because, as detailed above and as noted previously, there are no references or objections to avoid. Having said that, the Assignee notes that the absence of any relevant prior art led to a decision to broaden the claims by removing limitations and by correcting clerical errors in order to place the application in a final form for allowance and issue.

**Reservation of rights**

The Assignee hereby explicitly reserves the right to present the previously modified and/or canceled claims for re-examination in their original format. The cancellation or modification of pending claims to put the instant application in a final form for allowance and issue is not to be construed as a surrender of subject matters covered by the original claims before their cancellation or modification.

**Conclusion**

The pending claims are of a form and scope for allowance. Prompt notification thereof is requested.

Respectfully submitted,  
Asset Trust, Inc.  
/B.J. Bennett/  
B.J. Bennett, President  
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